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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,247	09/26/2003	Kohji Kanbara	243108US2	8580
22850 7590 07/24/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER CHAMPAGNE, DONALD				
ART UNIT 3688		PAPER NUMBER		
NOTIFICATION DATE 07/24/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/670,247

Applicant(s)

KANBARA, KOHJI

Examiner

Donald L. Champagne

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-27 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-27 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 April 2009 has been entered.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16-27 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (US006615183B1) in view of Short (US006462839B1).
4. Kolls teaches (independent claims 16, 22, 34, 35 and 36, and dependent claims 17 and 23) an image forming and information processing apparatus, and a banner advertisement method, the image forming apparatus (as represented by claim 16) comprising:

a communications mechanism (a *universal server*, col. 23 lines 8-9 and col. 13 lines 19-21, using *modem 544*, col. 25 lines 22-29) configured to communicate with a banner advertiser terminal (also the *universal server*, col. 23 lines 8-9) via a network (*network 600*, col. 23 lines 8-9 and col. 13 lines 24-25);

a banner advertisement storage unit (a *database*, col. 33 lines 44-52) configured to store at least two banner advertisements from the banner advertiser terminal (*universal server*);

a displaying mechanism (a *system 500*, col. 23 lines 9-12, with *display means 580 or 582* (col. 15 lines 1-3 and 21-23 and col. 7 lines 6-60 including Figs. 3B-3D, and col. 4 lines 13-14) configured to display a banner advertisement (col. 33 lines 63-65), stored in the

banner advertisement storage unit (*a database*, col. 33 lines 44-52), offering at least one of a product and services (col. 6 lines 11-18); and

a response sending mechanism (*LAN network connection means 556*, col. 15 lines 3-19) configured to send to the banner advertiser terminal, through the communications mechanism, at least one of an order and an inquiry for the at least one of the product and the services offered by the banner advertisement displayed on the displaying mechanism.

5. Kolls does not teach that said displaying mechanism is configured to display on a single body of the image forming apparatus that houses image forming mechanisms including copying and printing mechanisms. Short teaches a displaying mechanism that is configured to display on a single body of an image forming apparatus that houses image forming mechanisms including scanning (which reads on copying) and printing mechanisms (col. 2 lines 51-52 and 61-62. Under *KSR v. Teleflex* (82 USPQ 2nd 1385), the addition of Short's teaching to those of Kolls would be obvious because prior art elements are being combined according to known methods to yield predictable results. Kolls teaches every feature of the claims placing all the components into or on a single body. Short teaches that this is "conventional". It is obvious to follows convention.
6. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
7. The instant application contains no such clear definition for any of its claim terms, including ad "registration" (claims 20 and 26). The examiner interprets ad "registration" to mean "enrollment", establishing the ad in the server for delivery. This is inherent since Kolls

teaches delivery of the ads from the server (*universal server*, col. 13 lines 19-25) to the displaying mechanism, so they must have been "registered" with the server.

8. The claims are limited to various "mechanisms". While the term is generally broad (Google definitions), in context one of ordinary skill in the art would understand these mechanisms to be devices, which is to say machines or parts of machines.
9. For claims 17, 23, 34, 35 and 36, Kolls also teaches displaying when the image forming apparatus is in a "non-operative" state (col. 34 lines 39-41).
10. Kolls also teaches claims 18 and 24 (col. 44 lines 45, where "email" is interpreted as any electronic text communication), claim 19 and 25 (col. 17 lines 50-55, where *transaction receipt* reads on an order return message) and claims 21 and 27 (col. 12 line 49).

Response to Arguments

11. Applicant's arguments filed with an amendment on 23 April and 8 June 2009 have been fully considered but they are moot in view of the new basis of rejection.

Conclusion

12. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Todome (US pat. 5,070,467) teaches an integrated system, including a fax mechanism (*combination equipment 20*) in one body (*cabinet 28*, col. 3 lines 59 to col. 4 line 8, and col. 4 lines 12-27 and 51-55).
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached on Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
14. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private

PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

3 July 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688